

### REMARKS

Reconsideration and allowance in view of the following remarks are respectfully requested.

#### **Rejection of Claims 1-5, 7-16, 18-22 and 27-35 Under 35 U.S.C. §103(a)**

The Final Office Action rejects claims 1-5, 7-16, 18-22, and 27-35 under 35 USC 103(a) as being unpatentable over Lee et al. (U.S. Patent No. 5,748,789) ("Lee") in view of Lennon et al. (U.S. Patent No. 6,516,090) ("Lennon"). Applicant respectfully traverses this rejection and submits that for several reasons, claims 1-5, 7-16, 18-22, and 27-35 are patentable and in condition for allowance.

If the Examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the Examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the Applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of the evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of the evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 USC 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved is more probable than not. MPEP 2142.

In plainer terms, a preponderance of the evidence standard does not mean that no evidence exists in opposition. Preponderance of the evidence means that you figuratively place all evidence in favor on one side of a scale and place all evidence in opposition on the other side of the scale. The weightier evidence will prevail in a preponderance of the evidence standard. In

this case, under the preponderance of the evidence standard, Applicant has submitted weightier evidence than has the Examiner.

The Examiner has stated in the response to arguments that Applicant argued that there is *no* suggestion to combine Lennon and Lee, which is not the case. This is a strawman argument because when the Examiner characterizes our position as contending that there is no suggestion to combine Lennon and Lee, the Examiner only needs to produce a scintilla of evidence to overcome that argument. However, in a more appropriate balancing of evidence using the preponderance of the evidence standard, such a scintilla of evidence certainly may not outweigh the substantive evidence provided by Applicant. Thus, while a scintilla of evidence may be of sufficient strength to prevail against the strawman, the same scintilla of evidence is insufficient under the proper burden of proof to prevail against Applicant's presented evidence and arguments for not combining Lennon and Lee. Applicant's preponderance of the evidence burden requires only a showing that more evidence is in favor of not combining than combining Lennon and Lee.

In order to clarify the evidence presented on each side, first the Applicant will reiterate and analyze the arguments the Examiner has presented for combining Lennon and Lee and their relative weights. Next, Applicant will discuss and analyze arguments and evidence Applicant has presented previously as well as additional arguments that Lennon and Lee are not combinable.

In the Examiner's response to arguments dated April 18, 2007, the arguments presented on page 3, paragraphs 2 and 3 are just a few sentences followed by jumping to an unsupported conclusion that it would have been obvious to combine Lennon and Lee. In one example, on page 4, line 2, the Examiner states it would have been obvious to combine Lennon and Lee, but does not provide any evidence or argument in support of this claim. Applicant respectfully

submits that statements without adequate reasoning, analysis, or any citation to the teachings within the references should be given very little suggestive power in the balance of preponderance of the evidence test in a motivation to combine analysis. Further, the conclusion drawn by the Examiner is that it would have been obvious to one of skill in the art to combine the teachings of Lennon and Lee for precisely encoding spatial and temporal video data while maintaining high image quality, but Lennon teaches generating abbreviated high-level descriptions of video signals that capture the semantic context of the video signal. Lennon does not teach about encoding video data or maintaining video quality.

The argument presented on page 4 first full paragraph is that Lee and Lennon are reasonably combinable because both are analogously relevant to the MPEG video encoding environment. Just because two references are generally in the same field is not conclusive evidence that they are analogous art. See, for example, *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) where patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories. Furthermore, since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories, the finding that the reference was nonanalogous was supported by substantial evidence. MPEP 2141.01(a).

Like the Wang Laboratories SIMM case above, even though both Lee and Lennon are marginally related to video processing, they are in distinct and separate fields within video processing. Lennon and Lee contain different goals, different focuses, and different areas of technical expertise. Lennon's main teaching is comprehending content of a video signal by identifying significant objects or regions and analyzing their spatial arrangement. Lennon also teaches generating semantic labels for use in content retrieval and video abstract generation. Lennon teaches image interpretation, understanding, and comprehension; Lennon does not teach anything regarding MPEG or compression related technologies. In fact, Lennon references a generic digital video source without any regard to whether it is MPEG encoded or not. Lennon teaches nothing about saving space or compression in a video encoding context; Lennon teaches interpreting video signals for content-based retrieval and generating video abstracts.

In contrast to the teachings of Lennon, Lee's teachings relate directly to video compression. Lee teaches skipping unnecessary blocks for texture and motion coding in order to save space when storing a bitstream. Lee's teachings are dependent on video compression. Lee is not concerned at all with identifying or comprehending the content of a video as a particular object; Lee merely identifies blocks which may safely be skipped in a video compression algorithm such as MPEG. Lennon's goal of content interpretation is different from Lee's goal of improving video compression by reducing storage space because Lennon and Lee solve different video-related problems. The Examiner's argument that both Lee and Lennon are analogously relevant to each other merely because of their common link to video processing environments is insufficiently supported because interpreting the content of a video is a much different endeavor than improving encoding efficiency by skipping portions.

Applicant reasserts that a person of ordinary skill in the art when the invention was unknown and just before it was made would not have had sufficient motivation or suggestion to

combine Lee with Lennon because their combination may frustrate an intended function of Lennon, namely the automated video content interpretation. Lennon teaches content interpretation for content-based retrieval and video abstract generation. Lee identifies blocks which are transparent, i.e. covered by another object, in order to skip motion or texture coding and save space when compressing. Lee skips encoding transparent blocks thereby reducing the necessary storage space to store a video stream, potentially frustrating Lennon's purpose of identifying and interpreting video content. If certain blocks are skipped like Lee teaches, then Lennon may not be able to adequately identify the content of a video, interpret the content, and generate an abstract of the content of the video. Thus, if Lennon and Lee were combined, intended functions of Lennon could be frustrated.

Accordingly, Applicant respectfully submits that these references are not analogous, not in the same field of invention, and that one of skill in the art would not, by a preponderance of the evidence, have sufficient motivation or suggestion to combine these references to improve the efficient compression of movies. Even if the references are analogous, some of the intended functions of Lennon could be or frustrated if Lennon and Lee are combined. For these reasons, Applicant respectfully submits that claims 1-5, 7-16, 18-22 and 27-35 are patentable and in condition for allowance.

**CONCLUSION**

Having addressed all rejections and objections, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Law Office of Thomas M. Isaacson, LLC, Account No. 50-2960** for any deficiency or overpayment.

Respectfully submitted,

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